

Serial No. 10/767,784
Filed: January 29, 2004

REMARKS

With entry of the present amendment claims 1 to 19 and 22 to 24 are pending. Claims 20 and 21, directed to a nonelected invention, have been canceled without prejudice or disclaimer to the filing of a divisional application.

No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

RESTRICTION REQUIREMENT/AMENDMENTS

A Restriction Requirement was issued May 5, 2006, in which the claims were grouped on the basis of the C ring on the compound. Claim 1 is a generic linking claim, linking all of the groups of compounds delineated in the restriction requirement. The process and method claims were divided in accordance with the compound claims.

Although Applicants traversed the Restriction Requirement, the present Office Action indicates that the requirement has been made final and that “groups II to XLII have been withdrawn from consideration as being drawn to a nonelected invention, there being no allowable generic or linking claim. (emphasis added) However, the Office Action does not provide any rejection of the generic/linking claim and does not articulate any basis for the generic/linking claim not being allowable. In fact, it appears that the generic/linking claim was not examined beyond the scope of elected Group I.

M.P.E.P. § 809 provides the procedure for restriction and examination of an application containing linking claims. This section provides that “the linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between

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the linked inventions must be withdrawn. Any claim(s) directed to the non-elected invention(s), previously withdrawn from consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.”

Here, it appears that the linking claim was not examined with the elected invention as required. In other words, it appears that the claims were examined only to the extent that they included compounds where C is phenyl. When no art was found, the Patent Office is required to extend search and examination of the linking claim to the extent necessary to determine its patentability. If the linking claim is not allowable, a rejection articulating the reasons should be made of record. If the linking claim is allowable, the restriction requirement must be withdrawn and the nonelected claims examined fully. Neither of these courses of action has been taken by the Patent Office in this application.

The Office Action further indicates that in accordance with Ex parte Quayle, prosecution on the merits is closed. In view of the fact that the procedure for examination of linking claims was not followed, Applicants respectfully submit that closing of prosecution at this point is premature. Therefore, Applicants respectfully request that prosecution of the application be reopened and the generic/linking claim be examined to the extent necessary to determine its patentability.

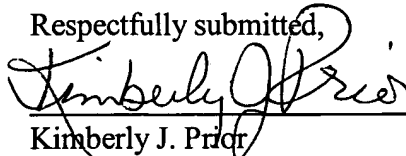
Applicants have filed a petition concurrent with the filing of this response. The petition requests reopening of prosecution on the merits, withdrawal of the restriction requirement, and further examination of the application to the extent necessary to determine patentability of the generic/linking claim.

The foregoing amendment is fully responsive to the Office Action issued October 4, 2005. Applicants submit that Claims 1 to 19 and 22 to 24 are allowable. Early and favorable consideration is earnestly solicited.

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If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kimberly J. Prior", written over a horizontal line.

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